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|                                      |   |                      |
|--------------------------------------|---|----------------------|
| In re Application of KUHNE et al     | : |                      |
| U.S. Application No.: 10/049,658     | : |                      |
| Int. Application No.: PCT/US00/22610 | : | DECISION ON PETITION |
| Int. Filing Date: 18 August 2000     | : |                      |
| Priority Date: 18 August 1999        | : | UNDER 37 CFR 1.47(a) |
| Attorney Docket No.: 25708.0038      | : |                      |
| For: CHEMICALLY-STABILIZED CHLORITE  | : |                      |
| SOLUTIONS FOR TREATING CANCER        | : |                      |
| AND OTHER DISEASES                   | : |                      |

This is in response to applicant's "Petition to Accompany Oath or Declaration When There is a Nonsigning Inventor Under 37 C.F.R. § 1.47" filed 18 November 2002, requesting that the present application be accepted for United States national stage processing without the signature of one of the joint inventors.

### **BACKGROUND**

On 18 August 2000, applicant filed international application PCT/US00/22610, which claimed priority of an earlier United States application filed 18 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 18 February 2002.

On 15 February 2002, applicant filed national stage papers with the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 17 April 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 18 November 2002, applicant filed the present petition under 37 CFR 1.47(a).

On 25 November 2002, the DO/EO/US mailed a Notice of Abandonment.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, the declaration filed with the petition is improper. Specifically, pages 1 and 2 of the declaration appear to be copies of original sheets, but page 3 of the declaration appears to be a copy of a sheet transmitted by facsimile. This suggests that the first two pages of the declaration were not associated with the signature page at the time of execution, thus rendering the execution improper. Applicant must provide a complete declaration which is presented to and signed by the executors. Furthermore, the signature block of inventor Vitam Kodelja is improperly crossed out. Moreover, both Kuehne and Kodelja are listed as the first inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, petitioner states that several attempts to contact Dr. Kodelja were made. However, petitioner has not provided adequate details regarding such purported attempts. First, petitioner must demonstrate that a bona fide attempt was made to present a copy of the complete application papers (including specification, claims, drawings, and oath/declaration) to Dr. Kodelja for signature. Although the petition states that a courier package was delivered to Dr. Kodelja's home on 27 September 2002, the contents of such package have not been described in an affidavit signed by the person with firsthand knowledge of the correspondence. Thus, it cannot be determined whether Dr. Kodelja has received a copy of the complete application papers. It is noted that the 27 September 2002 package was not signed for by Dr. Kodelja. Furthermore, applicant has not provided a copy of a cover letter of instructions which directs Dr. Kodelja to respond within a certain period of time. Thus, it cannot be reasonably concluded at the present time that Dr. Kodelja refuses to join in the application. Petitioner should provide an affidavit of the person with firsthand knowledge which describes specific details of the alleged multiple attempts to secure Dr. Kodelja's signature and explains why Dr. Kodelja's conduct demonstrates a refusal to sign.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known of the nonsigning inventor.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

The Notice of Abandonment mailed 25 November 2002 is hereby VACATED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

  
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